

**California Bar Intellectual Property (IP) Section  
Patent Standing Committee**

**Minutes of Teleconference Meeting of June 4, 2004**

In attendance were:

Dabney Eastham  
Ben Borson  
Tom Ward  
Paul Kovelman  
Richard Johnson  
Sivon Kalminov  
Charles Berkman  
Patric Rawlins  
Bernie Rose  
Rose Santillano  
Mike Sumachi  
John O'Banion

**I. Call to Order/Approval of Previous Meeting Minutes**

Dabney Eastham called the meeting to order, and the meeting minutes from the March 24, 2004 were approved.

**II. Discussion on Letter Commenting on Proposed PTO Rules of Professional Responsibility (Borson)**

The meeting date was set for June 4, 2004 to enable review and modification of the comments for submission to the PTO on the Proposed PTO Rules of Professional Responsibility prepared by a committee from the IP section of the State Bar of California formed by Ben Borson for submission before the extended deadline of June 11, 2004. Ben emailed a draft of the comments for review prior to the meeting.

Ben led the discussion point by point through the comments. Ben noted that the reason for the comments was to provide a legislative history for people to use when the rules are applied. Ben noted it had been 15 years since the last revision, and we could possibly suggest just amending the current rules rather than substitution of the ABA rules.

Initially, regarding the introductory disclaimer, Paul Kovelman mentioned changes had been made before the last draft to the disclaimer provisions to satisfy the California Bar Officials.

Regarding Section 11.22, Dabney mentioned comments regarding criminal fairness standards, indicating constitutional safeguards should still be in place. Dabney mentioned that the 14<sup>th</sup> amendment applies to state action and not federal action, and suggested removing the reference to the 14<sup>th</sup> Amendment, to which Ben replied the change would be made. Ben mentioned under the rules, a committee will determine “probable cause” similar to a criminal court, and an investigation may be brought based on “any information,” including a phone call from a person simply saying investigate person “x” someone I don’t like. Dabney further mentioned that the OED may call and say “turn certain information over to clear your name,” violating an attorney client privilege. Finally Paul mentioned that we will likely get no more bites at the apple according to comments from PTO General Counsel James Toupin, so we should make all comments now. All comment provisions relating to Section 22 were, accordingly left intact.

Regarding Section 11.23(c) Dabney mentioned that there is no legislative mandate or review by the legislature, but constitutional safeguards should still remain in place.

Regarding Section 11.24, Paul mentioned that Mr. Toupin stated that if there is a conflict between state rights regarding client confidentiality/privilege and federal rules regarding a reporting under Rule 56 that preemption would apply. Ben said that he had mentioned the 11<sup>th</sup> amendment in response, but Mr. Toupin had no reply.

Regarding Section 11.28(e) Dabney mentioned elimination of a portion of the comments, but stated that since “addiction” to coffee may count, he opted to follow Paul Kovelman’s suggestion that if we don’t comment now we may not get a second chance.

Regarding Section 11.34 Ben mentioned the added language that all discipline is supported by a low “probable cause” standard, as opposed to a higher previous standard.

Regarding Section 11.39, it was mentioned that the “Hearing Officer” will be an “ALJ” appointed by the BOPA.

Regarding Section 11.52, Dabney suggested that discovery should be permitted according to the Federal Rules of Civil Procedure.

Regarding Section 11.56(c), Dabney suggested that requests for reconsideration should not be limited to newly discovered evidence and should be allowed when the Director failed to consider the law or facts or made some egregious error. The rules of various courts contain examples of the permissible grounds.

Regarding Section 11.101, Dabney suggested that Subsection 101(c)(4) (“frivolous applications”) should be omitted rather than clarified.

Regarding Section 11.105, Dabney suggested that the PTO should adopt the prohibition fees that are illegal or unconscionable of California Rule of Professional Conduct 4.200. This is easier to determine than “reasonable.”

Regarding Section 11.110, Dabney suggested that the comment replace the phrase “Chinese wall” with the more current and politically correct term “ethical wall.”

Regarding Section 11.203(c), Dabney suggested that it is unintelligible and requires clarification.

Regarding Section 11.303(a), Dabney noted that it is not clear what is a “tribunal.”

Regarding Section 11.601, Dabney noted that the obligation to perform pro bono publico work is not in the California rules and that conceivably one might be disciplined for not doing pro bono work for indigent inventors or making financial contributions to legal aid societies for indigent inventors. He suggested that this section should be eliminated.}

Regarding Sections 11.803(a) and (b), Dabney suggested that they should be eliminated to avoid imposing an affirmative obligation to inform on other practitioners.

Regarding Section 11.803(a), it was agreed that a *mens rea* standard should be added, such as “knowingly or negligently violating or attempting to violate the rules.”

Regarding Section 11.806, it was agreed that the Commission would recommend the deletion of Section 11.806(b)(2) prohibiting the sexual harassment of employees because the USPTO should not make matters that are not arguably related to representation of the client into disciplinary offenses. Sexual harassment of an employee already has well-known remedies in federal and state law.

### **III. Other Scheduled Items**

Due to limited time, Dabney Eastham emailed his case notes relating to the currently pending malpractice cases of *Kairos Scientific v. Fish & Richardson*, and *Deposition Sciences Inc. v. Reed Smith*.

### **IV. Future Patent Standing Committee Meeting**

The next meeting was proposed to be in September. (The teleconference meeting is now scheduled for Wednesday, September 22, 2004.)

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**Thomas A. Ward**  
**Secretary, Patent Standing Committee**